

REMARKS

Claims 23-39 were pending in this application; of those claims 23-39 were rejected and claim 23 was objected to. Claims 23 and 34-38 have been amended. New claims 40-47 have been added to particularly point out and distinctly claim embodiments of Applicant's invention. No new matter has been added, and support for claims 23, 34-38 and 40-47 can be found throughout the specification, as originally filed, for example, at page 11, line 10 through page 13, line 5.

The Applicants do not acquiesce to the propriety of any rejections, and the present amendments are made solely to expedite prosecution of this application. These amendments should not be construed as an abandonment or disclaimer of any originally-disclosed subject matter, and the Applicants reserve the right to file continuing or related applications directed to all disclosed subject matter.

Priority

The Office Action indicates that foreign priority to GB 0406015.8 is claimed in the Declaration, while GB 0406015.8 is identified in the Application Data Sheet as a prior foreign application for which priority is not claimed. Submitted herewith is a Supplemental Application Data Sheet to revise the priority information.

Claim Objections

A. The Office Action indicates that the amended claims filed July 7, 2010, included two claims numbered 34. Claims 34-38 have been renumbered as claims 35-39 to correct this inadvertent numbering error. Accordingly, Applicants believe that the claims are now correctly numbered, and withdrawal of this objection is respectfully requested.

B. Claim 23 has been objected to for using the article "a" rather than "the" in the recitation, "contacting the tagged protein with a conjugate of a chelating agent and a polymer particle." Claim 23 has been amended, as required. Accordingly, withdrawal of this objection is respectfully requested.

Rejection Under 35 U.S.C. §112 , 2nd Paragraph Rejection

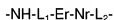
Claim 39 stands rejected under 35 U.S.C. 112, 2nd paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Office Action, there is insufficient antecedent basis for this recitation in claim 38, which is drawn to a protein covalently bound to a magnetic polymer particle.

Claim 39 has been amended to depend from claim 38 and to recite a "plurality of proteins." Reconsideration and withdrawal of the rejection are respectfully requested.

35 U.S.C. 103(a) Rejection

Claims 23-39 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 5,962,641 to Nelson et al. ("Nelson") in view of Chaga et al. (J. Chromatogr. A 864 (2), 1999, pages 247-256) ("Chaga"); and U.S. Patent No. 6,441,146 to Minh ("Minh"); and further in view of U.S. Patent No. 4,654,267 to Ugelstad et al. ("Ugelstad").

While Applicant does not agree with the merits of this rejection, claim 23 has been amended herein to recite, among others, "wherein the chelating agent is covalently linked to the polymer particle." Claim 37 has been amended herein to recite: "the linker further comprises a structure:



wherein L₁ is a linker comprising 1 to 10 atoms, L₂ is a linker comprising 1 to 10 atoms, Er is an electrophile residue, and N_r is a nucleophile residue." Claim 38 has been amended herein to recite: "the linking group comprises at least three linking atoms."

The combination of cited references fails to disclose or suggest at least these limitations of claims 23, 37 and 38. Since the combination of references does not teach each and every limitation of claims 23, 37 and 38, a *prima facie* case of obviousness has not been established with respect to these claims or the claims depending from claims 23, 37 or 38. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

Provisional Double-Patenting Rejection

Claims 23-39 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-17, 19-23 and 27 of copending Application No. 12/643,617 (PGPUB 2010/0222508), which is a continuation of Application No. 10/562,694, now abandoned, in view of Chaga; and Minh, issued on 08/27/2002 (cited in the specification).

Applicants respectfully request that the provisional non-statutory obviousness-type double patenting rejection be held in abeyance until allowance of the instant application and/or copending Application No. 12/643,617.

CONCLUSION

In view of the above remarks, it is submitted that this application is now ready for allowance. Early notice to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (541)-335-0070.

Respectfully submitted,

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